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In re Application of:
BELLOTT, Emile, M., et al.
U.S. Application No.: 10/584,821
PCT No.: PCT/US2004/043087
International Filing Date: 23 December 2004
Priority Date: 24 December 2003
Atty Docket No.: MLA.028NP
For: SMMR (SMALL MOLECULE
METABOLITE REPORTERS) FOR
USE AS IN VIVO GLUCOSE
BIOSENSORS

DECISION ON PETITION

This decision is issued in response to the "Petition Under 37 CFR 1.181(a) To Withdraw Holding Of Abandonment" filed 13 March 2008. No petition fee is required.

BACKGROUND

On 23 December 2004, applicants filed international application PCT/US2004/043087. The international application claimed a priority date of 24 December 2003, and it designated the United States. The deadline for submission of the basic national fee was thirty months from the priority date, i.e., 26 June 2006 (24 June 2006 was a Saturday).

On 26 June 2006, applicant filed a Transmittal Letter requesting entry into the national stage in the United States accompanied by, among other materials, payment of the basic national fee.

On 22 March 2007, the United States Designated/Elected Office (DO/EO/US) mailed a Notification of Missing Requirements (Form PCT/DO/EO/905) indicating that an oath or declaration in compliance with 37 CFR 1.497 and payment of the search fee, the examination fee, and the surcharge for filing the oath or declaration later than thirty months after the priority date were required.

On 22 October 2007, applicants filed a "Response To Missing Requirements Under 35 U.S.C. 371" (with required five-month extension fee). The response included payment of the required surcharge, search fee, and examination, as well as an executed ten-page declaration document.

On 11 February 2008, the DO/EO/US mailed a Notification Of Abandonment (Form PCT/DO/EO/909) indicating that the application was abandoned because the declaration filed on 22 October 2007 was an unacceptable compilation of separate declaration documents.

On 13 March 2008, applicant filed the "Petition Under 37 CFR 1.181(a) To Withdraw Holding Of Abandonment" considered herein, accompanied by complete copies of the four-page declarations executed by each of the inventors herein.

DISCUSSION

As correctly noted in the Notification Of Abandonment mailed 11 February 2008, the declaration document filed by applicants on 22 October 2007 was a defective compilation of multiple declaration documents. However, as set forth in 37 CFR 1.135(c):

When reply by the applicant is a *bona fide* attempt to advance the application to final action, and is substantially a complete reply to the non-final Office action, but consideration of some matter or compliance with some requirement has been inadvertently omitted, applicant may be given a new time period for reply under § 1.134 to supply the omission.

The submission of the executed but defective declarations on 22 October 2007 is considered a *bona fide* attempt to satisfy the declaration requirement contained in the Notification of Missing Requirements. Accordingly, rather than a Notification Of Abandonment, a "Notification Of Defective Response" (Form PCT/DO/EO/916) identifying the defect in the filed declaration document and requiring submission of an acceptable declaration within a one-month, non-extendable deadline should have been mailed in response to the filing of the defective declarations.

The mailing of the "Notification Of Abandonment" (Form PCT/DO/EO/909) without first permitting applicants the opportunity to file a timely response to a "Notification Of Defective Response" (Form PCT/DO/EO/916) was improper. The "Notification Of Abandonment" (Form PCT/DO/EO/909) mailed 11 February 2008 is therefore properly vacated, as requested by applicants in the present petition.

It is noted that the present petition was accompanied by complete copies of the four-page declarations executed by each of the inventors. The submission of these declarations resolves the compilation defect identified in the vacated Notification of Abandonment.

CONCLUSION

The petition to withdraw the holding of abandonment is **GRANTED**.

The Notification of Abandonment (Form PCT/DO/EO/909) mailed 11 February 2008 is hereby **VACATED**.

The complete declarations filed 13 March 2008 are accepted in compliance with 37 CFR 1.497.

This application is being returned to the National Stage Processing Branch of the Office of PCT operations for further processing in accordance with this decision. The date under 35 U.S.C. 371(c)(1), (c)(2), and (c)(4) is 13 March 2008.



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